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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
MCCRAW, BARRY CLAYTON	
ART UNIT	**PAPER NUMBER**
3744	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/779,987	PERRY ET AL.	
	Examiner	Art Unit	
	B. Clayton McCraw	3744	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 May 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-33,35-37 and 39* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3-30,32-33, 35-37, and 39* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 5/02/2006 have been fully considered but they are not persuasive. Regarding claim 1, the applicant argues that there exists no motivation to combine the Pool reference with Smith et al. because Pool discloses an insulated paperboard shipping container while Smith et al. provides a temperature controlled container which may be cooled by an evaporator. The applicant suggests that the difference that exists between Pool and Smith et al. in solving the problem of insulating a container leaves no motivation to combine the references. The examiner respectfully disagrees. Pool teaches all of the elements of the present invention except for an inner container. Smith et al., providing a cooling container as well, teach an internal container. In response to the applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In this case, it would be obvious to add an internal container to Pool's reference since an inner container is simply one type of the contents an outer container is designed to hold.

The applicant also submits that any understanding or principle within the knowledge of one of ordinary skill in the art would not have provided motivation

to combine Pool with Smith et al. However, one of ordinary skill in the art would clearly understand that adding an internal container not only isolates its contents from other possible contents of the container, but also adds another layer between the cooled contents and the ambient air, providing extra insulation.

Regarding claim 23, the applicant submits that there exists no motivation to combine Henning et al. with Pool and Smith et al. Assuming *arguendo*, no motivation exists to combine Henning et al. with Pool and Smith et al., it would still have been obvious to one of ordinary skill in the art at the time the invention was made to provide multiple inner containers, since it has been held that mere duplication of the essential working parts of an invention involves only routine skill in the art. However, the fact that Henning et al. provides cooling at a different temperature does not preclude it from being combined with Pool and Smith et al. The difference in method of solving the problem is irrelevant to the fact that it would be obvious to combine Pool and Smith et al. with Henning et al. since certain applications may require multiple sealed goods to be shipped simultaneously and it would only require routine skill in the art to multiply the concept of a single container used for single goods.

Regarding claim 33, the applicant submits that there is no motivation to combine Thomas with Pool, Smith et al., and Henning et al. because the problem they solve problem is "totally unrelated" to the problem solved by Thomas. In response to applicant's argument that these references are nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with

which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. In this case, Thomas discloses a container designed to optimize packaging and shipping in given situations. This is also essentially what Pool, Smith et al., Henning et al., and the present invention aim to provide. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Thomas with Pool, Smith et al., and Henning et al. because spacers are commonly used in shipping applications to advantageously protect their shipping contents.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

4. Claims 1, 3-6, 11,16, and 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US

6,584,797). Pool explicitly teaches a plurality of dry ice pellets surrounding the inner contents (col.3, lines 47-49; used in plastic bag, 12), an outer container (11) for disposing the inner contents and dry ice pellets therein; a barrier bag filled with dry ice pellets and wrapping the inner contents (12; col. 3, lines 47-49; and Fig. 1); a lid placed on the barrier bag over the inner contents (15); the barrier bag assumes the interior contour of the outer container (col. 4, lines 54-57); the barrier bag includes an open top extending over the height of the container (col. 5, lines 10-13); the open top of the barrier bag is folder over the inner container and secured by tape (col. 5, lines 10-15); the container made of cardboard (corresponding to the claimed corrugated fiberboard; col.4, line 15); the outer container being secured by tape (col. 5, lines 13-15); a plurality of foam panels disposed in the outer container and surrounding the inner contents (13). Pool does not explicitly teach an inner container. Smith et al. teach an inner container (612) within an outer container (614) for a temperature controlled shipping apparatus. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool with the inner container as taught by Smith et al. since an inner container is simply one type of the contents the outer container is designed to hold.

Regarding the limitations of claim 1, dry ice pellets having a thickness of at least 2 inches are considered to be a result effective variable, wherein the amount and length of time of cooling provided will directly increase as a result of dry ice thickness. Thus, while Pool does not explicitly teach a layer of dry ice

pellets having at least a 2 inch thickness one of ordinary skill in the art would have known by increasing the dry ice thickness, a longer cooling time would advantageously result.

Regarding the limitations of claim 19, a foam panel thickness of about 2 inches is considered to be a result effective variable, wherein the cooling capacity will increase with an increasing foam panel thickness. Thus, while Pool does not explicitly teach a foam panel with at least a 2 inch thickness one of ordinary skill in the art would have known by increasing the foam panel thickness, a longer cooling time would advantageously result.

5. Claims 7 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in further view of Lenack (US 6,223,400). Pool and Smith et al. explicitly teach the aspects of the present invention as described above, but do not teach tape having a width of 2 inches, or an inner container being sealed by tape. Lenack explicitly teaches a container being sealed by tape having a width of 2 inches (col. 4, lines 23-27). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus of Pool and Smith et al. with the tape width of Lenack since sealing an inner container advantageously isolates its contents from other goods contained in the outer container.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in further view of Belmont et al. (US 4,880,316). Pool and Smith et al. explicitly teach the elements

of the present invention as described above, but fail to teach tape being applied perpendicularly across a bag. Belmont et al. explicitly teach tape being applied perpendicularly across a bag (col. 4, lines 22-52). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool and Smith et al. with the perpendicular application of tape as taught by Belmond et al. since applying tape perpendicularly advantageously ensures that the bag is fully closed.

7. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in further view of Benedetti et al. (US 6,209,341). Pool and Smith et al. teach the aspects of the present invention as described above, but fail to teach but do not teach the barrier bag having a plurality of vent holes with diameters approximately ¼ inches. Benedetti et al. explicitly teach a plurality of vent holes for a container containing dry ice (col. 5, lines 8-12) having a diameter of approximately ¼ inches (col. 5, lines 8-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool and Smith et al. with the vent holes as taught by Benedetti et al. as it is imperative for any container of carbon dioxide to have some form of ventilation so the structure does not explode as gases are emitted.

8. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in

further view of Allen (US 5,551563). Pool and Smith et al. teach the aspects of the present invention as described above, but fail to teach the cardboard container having a thickness of approximately 0.255 inches. Allen explicitly teaches a cardboard container having a thickness of about 0.255 inches (col. 6, lines 53-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made combine the temperature controlled shipping apparatus as taught by Pool and Smith et al. with the cardboard thickness as taught by Allen since it is advantageous to have thinner, lighter materials when shipping containers.

9. Claim 15 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in further view of United States Postal Service, "A Customer's Guide to Mailing" (Non Patent Literature). Pool and Smith et al. teach the aspects of the present invention as described above, but fail to teach tape having an H or T pattern on the outer container. "A Customer's Guide to Mailing" explicitly teaches tape having an H or T pattern on the outer container (Figure on page 15). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool and Smith et al. with the taping placement as taught by "A Customer's Guide to Mailing" since the United States Postal Service illustrates this tape placement as optimal tape placement for shipping containers.

10. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in further view of

Belisle (US 4,823,956). Pool and Smith et al. teach the aspects of the present invention as described above, but fail to teach the foam panels being sealed by tape. Belisle explicitly teaches foam panels being sealed by tape (col. 2, lines 8-16). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool and Smith et al. with the foam panel tape as taught by Belisle since it would be advantageous in any shipping application to hold the contents of a package together to prohibit movement.

11. Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in further view of Thomas (US 4,892,193). Pool and Smith et al. teach the aspects of the present invention as described above, but fail to teach at least one spacer disposed around the inner contents within the foam panels such that a cavity is formed between the inner contents and foam panels and the spacer having a thickness of about 2 inches. Thomas explicitly teaches at least one spacer disposed around the inner contents within the foam panels such that a cavity is formed between the inner contents and foam panels (col. 3, lines 12-22) and the spacer having a thickness of about 2 inches (col. 3, lines 23-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool and Smith et al. with the spacer cavity as taught by Thomas since spacers are commonly used in shipping applications to advantageously protect the shipping contents.

12. Claims 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in further view of Henning et al. (US 5,600,958). Pool and Smith et al. explicitly teach all of the elements of the present invention as stated above, but do not teach a plurality of internal containers for individually packing materials therein. Henning et al. explicitly teach a plurality of internal containers for individually packing materials therein (40; Figures 1 and 2); and a plurality of lids for the internal containers (50; Figure 1). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool and Smith et al. with the internal containers as taught by Henning et al. since certain applications may require multiple sealed goods to be shipped simultaneously and it would only require routine skill in the art to multiply the concept of a single container used for single goods.

13. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in further view of Henning et al. (US 5,600,958) and in further view of Allen (US 5,551563). Pool, Smith et al., and Henning et al. explicitly teach the aspects of the present invention as described above, but fail to teach the cardboard container having a thickness of approximately 0.255 inches. Allen explicitly teaches a cardboard container having a thickness of about 0.255 inches (col. 6, lines 53-63). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by

Pool, Smith et al., and Henning et al. with the cardboard thickness as taught by Allen since it is advantageous to have thinner, lighter materials when shipping containers.

14. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4,682,708) in view of Smith et al. (US 6,584,797) in further view of Henning et al. (US 5,600,958) and in further view of Farison et al. (US 6,398,029). Pool, Smith et al. and Henning et al. teach aspects of the present invention, but do not teach a cellulosic cushion disposed in the inner container. Farison et al. explicitly teach a cellulosic cushion for use in shipping containers (Figures 1-6; col. 18, lines 1-18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool, Smith et al. and Henning et al. with the cellulosic cushion as taught by Farison et al. since any increased padding within a shipping container advantageously increases its safety.

15. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4,682,708) in view of Smith et al. (US 6,584,797) in further view of Henning et al. (US 5,600,958) and in further view of Seki (US 5,396,985). Pool, Smith et al. and Henning et al. teach aspects of the present invention, but do not teach item reference tags attached to the internal containers. Seki explicitly teaches item reference tags attached to the internal containers (col. 5, lines 34-38). It would have been obvious to one or ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool, Smith et al. and Henning et al. with the reference tags as

taught by Seki, since reference tags would advantageously increase organization and clarity regarding the shipped items.

16. Claims 28 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4,682,708) in view of Smith et al. (US 6,584,797) in further view of Henning et al. (US 5,600,958) and in further view of Bane, III (US 5,441,170). Pool, Smith et al. and Henning et al. teach aspects of the present invention, but do not teach upper or lower holding pads in the inner container. Bane, III explicitly teaches upper (44) and lower (46) holding pads in an inner container. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool, Smith et al. and Henning et al. with the upper and lower holding pads as taught by Bane, III, since any form of extra padding above or below an object within a shipped container will advantageously increase safety during shipping.

17. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4,682,708) in view of Smith et al. (US 6,584,797) in further view of Henning et al. (US 5,600,958) and in further view of Bessett et al. (US 3,732,976). Pool, Smith et al. and Henning et al. teach aspects of the present invention, but do not teach a recessed portion conformal to a periphery of a bottom surface of internal contents. Bessett et al. explicitly teach a recessed portion conformal to a periphery of a bottom surface of internal contents (Figure 2). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus

as taught by Pool, Smith et al. and Henning et al. with the recessed portion of Bessett et al. since providing a recessed portion in a shipping container advantageously prevents movement of the contents within.

18. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4,682,708) in view of Smith et al. (US 6,584,797) in further view of Henning et al. (US 5,600,958) and in further view of Benedetti et al. (US 6,209,341). Pool, Smith et al. and Henning et al. teach aspects of the present invention, but do not teach the barrier bag having a plurality of vent holes. Benedetti et al. explicitly teach a plurality of vent holes for a container containing dry ice (col. 5, lines 8-12). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool, Smith et al. and Henning et al. with the vent holes as taught by Benedetti et al. as it is imperative for any container of carbon dioxide to have some form of ventilation so the structure does not explode as gases are emitted.

19. Claims 33, 35-37, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pool (US 4, 682,708) in view of Smith et al. (US 6,584,797) in further view of Henning et al. (US 5,600,958) and in further view of Thomas (US 4,892,193). Pool, Smith et al. and Henning et al. teach elements of the present invention, but do not teach at least one spacer disposed around the inner container to immobilize the inner container as to form a cavity between the inner and outer containers. Thomas explicitly teaches at least one spacer disposed around the inner contents within the foam panels such that a cavity is formed

between the inner contents and foam panels (col. 3, lines 12-22) and the spacer having a thickness of about 2 inches (col. 3, lines 23-37). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the temperature controlled shipping apparatus as taught by Pool and Smith et al. in view of Henning et al. with the spacer cavity as taught by Thomas since spacers are commonly used in shipping applications to advantageously protect the shipping contents.

Regarding the limitations of claims 37 and 39, dry ice pellets or foam panels consisting of a thickness of at least 2 inches are considered to be a result effective variable, wherein the amount and length of time of cooling provided will directly increase as a result of dry ice thickness. Thus, while Pool does not explicitly teach a layer of dry ice pellets having at least a 2 inch thickness one of ordinary skill in the art would have known by increasing the dry ice thickness, a longer cooling time would advantageously result.

Conclusion

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to B. Clayton McCraw whose telephone number is (571) 272-3665. The examiner can normally be reached on M-F 8:30AM-5:00PM.

21. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cheryl Tyler can be reached on (571) 272-4834. The fax

phone number for the organization where this application or proceeding is assigned is 571-273-8300.

22. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCM
7/31/2006

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